

Application Serial No. 10/657,583
Reply to Office Action dated June 6, 2005

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REMARKS/ARGUMENTS

The first Office Action received in the above-identified U.S. patent application set forth a seven-way restriction between the claimed subject matter in the application, i.e., the Examiner held that the application contained claims directed to seven distinct inventions covered by claims 1-4, 5-10, 11-14, 15-17, 18-22, 23-27 and 28-31 respectively. Although the Applicant filed a response on February 7, 2005 which traversed various aspects of the restriction, claims 18-31 were canceled to simplify matters. However, with respect to claims 1-17, it is respectfully submitted that the claims do not set forth inventions that are distinct in a manner which is restrictable under U.S. practice, but were rather directed to subcombinations of a common overall combination assembly as originally disclosed. To emphasize this point, new combination claim 32 was added to the application which includes each and every limitation of the various subcombination claims.

More specifically, it was previously submitted to the Examiner that many of the invention identification statements set forth on page 2 of the first Office Action were misleading, with these misleading statements being utilized as a justification for establishing the restriction groupings. For instance, the Examiner indicated that claims 11-14 are directed to a distinct invention and, more particularly, "drawn to a conveyor..." These claims are actually directed to an apparatus for nesting individual taco shells to form a nested group of taco shells. It is true that the apparatus includes a nester conveyor. However, it is respectfully submitted that categorizing the invention as a conveyor is extremely misleading and correspondingly fails to recognize the relevant subject matter therein in relation to the other claimed subject matter. For instance, these claims are directed to nesting individual taco shells to form a group of nested taco shells, while claims 15-17 are simply directed to additional structure of the apparatus for aligning the nested group of taco shells. Clearly, the Applicant has merely broken down individual portions of the overall apparatus or assembly in setting forth these individual claim sets. The same is true with respect to the structure for inserting an insert into the

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nested group of taco shells as set forth in claims 5-10. Finally, the overall assembly includes structure for folding the insert (claims 1-4) prior to inserting the same into the nested group of taco shells.

As indicated above, it is respectfully submitted that all of these features are actually sub-combination portions of the overall combined apparatus or assembly. To further bring out this important point, the Applicant did insert independent claim 32 which represents a combination claim directed to the overall assembly and includes all of the limitations of each of the subcombinations. Therefore, the overall assembly includes a first apparatus to fold the insert directly corresponding to that set forth in claim 1, an apparatus for nesting taco shells directly corresponding to that set forth in claim 11, an apparatus for placing an insert within a nested group of taco shells directly corresponding to that set forth in claim 5 and an apparatus for aligning the nested taco shells directly corresponding to that set forth in claim 15. As claim 32 represents a combination claim and links the other claim sets by including all the limitations and particulars of independent claims 1, 5, 11 and 15, these claims are related as combination and subcombination claims.

In the outstanding Office Action, the Examiner recognizes the combination/subcombination relationship between the claim sets but still maintains that the combination/subcombinations are distinct inventions. The recent Office Action dated June 6, 2005, correctly outlined the distinctions necessary to show a proper combination/subcombination restriction. At present, the Examiner has indicated that claim 32, drawn to the combination, is patentably distinct from each and every subcombination. In any case, the Examiner correctly identifies M.P.E.P. § 806.05(c) in stating that a proper combination/subcombination restriction must meet a two prong test, with the important portion of the test in relation to the present situation being that the combination as claimed does not require the particulars of the subcombination. On page 4 of the Office Action, the Examiner has lumped a brief discussion in stating that the combination is distinct from each of the subcombinations, without comparing the limitations of the subcombination and combination claims individually. That is, the

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Examiner states "the combination as claimed does not require the particulars of the subcombination... because other subcombination in the combination is also patentable by itself." It is respectfully submitted that as every single limitation of any given subcombination claim is fully incorporated into the combination claim, no independent subcombination claim can be properly restricted from the combination of claims 1, 5, 11 and 15. That is, the combination claim clearly requires all the particulars of the subcombination claims. It is respectfully submitted that it is not proper to state that the "other subcombination in the combination is also patentable by itself" as, at this point, the Examiner has not indicated any of these subcombinations to be patentable. In fact, the Examiner has taken the position in the outstanding Office Action that claim 1 is not patentable over the prior art!


This petition is being filed because the Examiner has made the restriction requirement final and withdrawn claims 5-17 and 32 as being directed to non-elected inventions. It is respectfully submitted that the Office Action does not provide any clear analysis as to how the Examiner is properly restricting claim 32 from claim 1, let alone how claim 32 could be possibly restricted from claims 5, 11 or 15. Clearly, as claim 32 requires all the particulars of claim 1, these claims cannot be properly restricted given the combination/subcombination status and the two-prong requirement for proper restriction under U.S.P.T.O. guidelines.

As previously argued, it is respectfully submitted that the Examiner's desire for the present application as originally claimed to be divided up into seven different applications is not justified. In addition, it is respectfully submitted that the Applicant has showed how each of these features are related to an overall invention such that identifying certain subcombination features as being remote to that invention, i.e., indicating claims 11-14 are actually drawn to a conveyor, is extremely misleading. In any case, it is respectfully requested that this restriction requirement be withdrawn and claims 1-17 and 32 be examined in the present application. Again, to further the prosecution, the Applicant has already agreed to withdraw claims 18-31, while reserving the right to file one or more applications on this subject matter. In essence, the Applicant

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agreed with the Examiner that a proper restriction could be made in this application and, in fact, if taken to the extreme, a proper restriction resulting in three separate applications for the originally claimed subject matter. However, the seven separate application requirement being set forth by the Examiner is considered unreasonable and has resulted in the filing of this petition. If there should be any questions or concerns regarding this petition, the appropriate Patent Office personnel is respectfully requested to contact the undersigned at the number provided below to further expedite the prosecution.

Respectfully submitted,



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